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JAN 28 2005

OFFICE OF PETITIONS

In re Application of :
Douglas J. Kudney et al. :
Application No. 10/665,601 : DECISION REFUSING STATUS
Filed: September 22, 2003 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 3156-0119P :
:

This decision is in response to the petition filed March 16, 2004, under 37 CFR 1.47(b), in response to the Notice to File Missing Parts "Notice" mailed December 16, 2003, which is treated under 37 CFR 1.47(a).

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to respond, correcting the below-noted deficiencies. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on September 22, 2003, naming Douglas J. Kudney, Karen Breitbach and David H. Anderson as joint inventors, but without a signed declaration. Accordingly, on December 16, 2003, a "Notice To File Missing Parts of Application" was mailed, requiring *inter alia* a properly executed oath or declaration.

In response, the present petition, with a one month extension of time, was filed with an oath or declaration signed only by joint inventor Anderson. Petitioners seek status under 37 CFR 1.47(b) based on the fact that the declaration was sent to Mr. Kudney's and Ms. Breitbach's last known address and based on the fact that both Mr. Kudney and Ms. Breitbach verbally refused to sign the declaration, in spite of efforts to have the oath or declaration executed.

At the outset, petitioner is advised that if none of the named inventor(s) will sign the oath or declaration, a petition under 37 CFR 1.47(b) must be filed. If some of the named inventors signed the oath or declaration and one or more of the named inventors have not signed the declaration, a petition under 37 CFR 1.47(a) must be filed. In the instant case, three inventors have been named but the oath or declaration has only been executed by one of the inventors, thus, this petition will be treated under 37 CFR 1.47(a).

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the

oath or declaration after having been presented with the application papers (specification, claims and drawings);

- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and
- (4) a statement of the last known address of the non-signing inventor.

The present petition lacks item (1).

In regards to item (1), petitioners have not provided sufficient proof that a copy of the application (specification, including claims, drawings, if any, and the declaration) was sent to the non-signing inventors. The declaration by Nancy Page regarding efforts to reach Mr. Kudney and Ms. Breitbach, reveals that the declaration was sent to them, but don't indicate that the complete application was ever sent to them. Thus, there is no evidence to show that the non-signing inventors had the benefit of reviewing the application.

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventors for review by providing a copy of the cover letter transmitting the application papers to the non-signing inventors or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Likewise, before a *bona fide* refusal can be shown, the non-signing inventor must have been given an opportunity to review the application. Therefore, petitioners must show proof that the non-signing inventor refuses to sign the declaration after being sent or given a copy of the application papers. If there is a written refusal, petitioners should submit a copy of that refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Office of Petitions

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.


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